



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of

Magnus N. NILSSON et al

Serial No.: 09/964,832⁸

Filed: September 28, 2001

For: A PROCESS FOR THE MANUFACTURE OF SURFACE ELEMENTS

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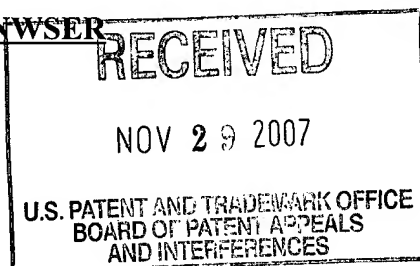
DEC 17 2007 Group Art Unit: 1732

TC 1706 Examiner: M. Huson

REPLY BRIEF TO EXAMINER'S ANSWER

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:



Responsive to the Examiner's Answer dated September 20, 2007, as supplemented by the Office Communication dated October 23, 2007, Appellants hereby response to the issues raised by the Examiner in the Answer.

Paragraph (10)A

In response to paragraph (10)A the Examiner has characterized Appellants' argument as contending "that Scher does not teach a wear layer, instead Scher teaches a layer of melamine resin and pigment which coats the design layer...". This restatement of Appellants' claim by the Examiner simply mischaracterizes the claimed invention.

As set forth in process claim 27 claiming a process for the manufacture of a decorative surface element, the element is defined as "comprising a base layer, a decor and a wear layer of a UV or electron beam curing lacquer," and furthermore, the positioning of one or more structured rollers or molds on top of the lacquer, the rollers or molds being provided with embossing surfaces and the pressing of the rollers or molds into the lacquer causes the lacquer to be provided with surface structure thereby enhancing the decorative effect of the decor and "thereafter completely curing the wear layer by applying a UV or electron beam." Appellants' claim continues "wherein the wear layer is applied in several steps with intermediate partial

curing between said steps by applying UV or electron beam”. This is simply not shown in the Scher reference nor corrected by the proposed combination of Scher and Correll. Scher teaches a layer of melamine resin and pigment which is nowhere alleged to be a lacquer. Although the Examiner alleges no particular properties or structures are claimed, Appellants respectfully request the Board to recognize that the limitation of “UV or electron beam” is a positive limitation as is the term “lacquer” and furthermore that the curing of such lacquer by “applying a UV or electron beam” is simply not the equivalent of a melamine resin and pigment as found in the Scher reference. The Examiner now states that “Scher was not cited to show a UV curing lacquer that is cured with a UV beam” and hence now recognizes the defect in Scher. Although Scher is combined with Correll, Correll is not directed to subject matter which cures the deficiencies of Scher. Correll forms coatings on substrates “by applying a layer of curable material in dry powder form and then melting and curing the material... by compressing the layer” *See* Abstract. Appellants again respectfully submit that the term “lacquer” and “UV curing lacquer” are nowhere taught by the “dry powder” of Correll. Furthermore, there is no teaching of applying the lacquer in several steps with intermediate partial curing as set forth in independent claim 27. The Examiner cites column 6, lines 66-67, column 7, lines 1-2, column 8, lines 20-22, column 8, lines 60-63 of Correll, but such does not make the melted powder layer of Correll into a lacquer and hence there is no partial curing of the lacquer by UV or electron beam radiation in any proposed combination of Scher, Schmooch and Correll.

Paragraph (10)B

Appellants have previously argued that the combination of Scher and Schmooch do not suggest the possibility of glazing rollers. The Examiner has found this not persuasive because he alleges “it is maintained that Scher and Schmooch suggest that rollers can be provided to inflict any desired surface texture, and include that [surface textures] which is ‘merely smooth’” (emphasis added). However, Appellants contend a glazed surface is different than a “simply smooth” surface and the Examiner apparently recognizes that a smooth surface is different than a “glassy (*i.e.*, glazed) surface” in the last sentence of paragraph (10)B, of the Answer. Thus, the Examiner still has not addressed why one skilled in the art would use a glazing roller, when at

best his proposed combination of Scher and Schmooch would suggest a smooth surface could be formed but supports Appellants' argument that "smooth" and "glazed" surfaces are in fact different.

Paragraphs (10)C-G

Paragraph (10)C-G, require no additional comment, because the Examiner apparently premises this rejection on the combination of Scher and Schmooch as teaching the claimed subject matter, which Applicants have pointed out above, they simply do not. Thus, the secondary references are not cited to cure this deficiencies and absent a finding that Scher and Schmooch teach glazing rollers each of the rejections set forth must fall.

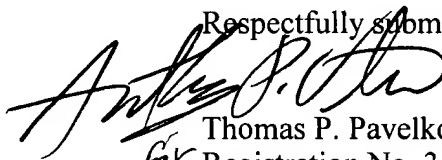
Paragraph (10) H

With regard to paragraph (10)H, Appellants respectfully submit they have provided the "more" evidence by showing that, even with the excessive number of references, the Examiner still has not found the recited limitations of the claims. This weighs against the obviousness of the proposed aggregation of references to allege a *prima facie* case of obviousness. While the Examiner denies relying upon impermissible hindsight Appellants respectfully submit that as noted above, a melamine resin or a melted powder simply does not form a lacquer, and in the absence of a UV or electron beam curing lacquer, the claimed process steps cannot be achieved-in any of the proposed combination of references. For the foregoing reasons, Appellants respectfully submit the rejections fail to establish a *prima facie* case of obviousness for the claimed invention and reversal of each of the rejections by the Board is respectfully requested.

TPP/mvj
Attorney Docket No.: TPP 31424

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Date: November 20, 2007

Respectfully submitted,

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